REMARKS

Claims 33-49 are pending in this application. Claims 33, 34 and 36-49 are rejected as follows: claims 35, 42 and 46 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 6, 7 and 8 of U.S. Patent No. 6,701,314 ("the '314 patent"); claims 33, 34, 36-40 and 42-49 are rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent Number 6,182,066 to Marques ("Marques") in view of U.S. Patent Number 6,151,624 to Teare et al. ("Teare"); claim 41 is rejected under 35 U.S.C §103(a) as being unpatentable over Marques and Teare as applied to claim 33 and further in view of U.S. Patent No. 6,301,579 B1 to Becker ("Becker"). Claim 35 is objected to as being dependent upon a rejected base claim. The undersigned thanks the Office for this indication of allowability. In view of the remarks presented herein, the undersigned respectfully traverses these rejections as set forth below.

Rejection of Claims 35, 42 and 46 Under Non-Statutory Obviousness-type Double Patenting

Claims 35, 42 and 46 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 6, 7 and 8 of U.S. Patent No. 6,701,314. Quoting from the MPEP 804II(B)(1):

> A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The undersigned submits that the highlighted limitations in the Office's chart are not explicitly recited in any claim of the '314 patent. Accordingly, the undersigned submits that a *prima facie* case has not been established since there is no teaching provided for the highlighted limitations.

The undersigned will consider filing a terminal disclaimer once the claims have been indicated as being allowable over the non co-owned prior art.

Rejection of Claims 33, 34, 36-40 and 42-49 Under 35 U.S.C. §103(a)

Claims 33, 34, 36-40 and 42-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,182,066 to Marques ("Marques") in view of U.S. Patent No. 6,151,624 to Teare et al. ("Teare").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) MPEP §2142.

The Office Action has failed to meet the burden of establishing a prima facie case for obviousness. With regard to element 1, the Office is required to establish some motivation to

combine the references that are alleged to obviate the claims of the present invention.

Specifically, regarding independent claims 33, 42 and 46, the Office states:

> Metadata mechanism as taught by Teare is a must for the Marques system because metadata as disclosed by Marques at Col. 3, Lines 45-57 will be more relevant to a network resource if it is defined by network resource's author. By including the Teare metadata mechanism, metadata as disclosed by Marques will be updated corresponding to the updated network resource by indexing and storing metadata in a database.

In this passage, the Office takes an inconsistent position regarding the use and importance of the metadata. The Office asserts that the metadata mechanism as taught by Teare is a *must* in the Marques system and that such technology "would have been obvious for one of ordinary skill in the art at the time the invention was made to include metadata mechanism." However, the Office recognizes that Marques fails to teach or suggest the availability or use of such a critical piece of technology as taught in Teare and the present application. In fact, the mere brief mention of the use of metadata in Marques col. 3, lines 45-57, as identified by Office, does not suggest that the use of such metadata is intended to function with the same sophistication and specificity of the metadata mechanism of the present application nor the metadata mechanism identified in the Teare patent. Therefore, the importance of such technology as applied to Marques cannot be assumed retrospectively in the absence of a suggestion from the reference that the use of such intricate technology was intended.

Again, the mere fact that the Marques patent references the use of metadata does not qualify as a suggestion to combine Marques with a reference that identifies an intricate metadata mechanism, such as Teare, in order to properly reject the claims of the present application under 35 U.S.C. §103(a). Therefore, it seems that the Office has inappropriately used hindsight to combine the Marques and Teare references to form the basis of a §103(a)

rejection of independent claims 33, 42 and 46 of the present application and all claims that depend therefrom. Accordingly, the undersigned representative request the rejection of claims 33, 34, 36-40 and 42-49 under 35 U.S.C. §103(a) as being unpatentable over Marques in view of Teare be reconsidered and withdrawn.

Rejection of Claim 41 Under 35 U.S.C. §103(a)

Claim 41 is rejected under 35 U.S.C. §103(a) as being unpatentable over Marques and Teare as applied to claim 33 and further in view of U.S. Patent No. 6,301,579 B1 to Becker ("Becker"). For at least the reasons set forth in the preceding section, the undersigned representative request the rejection of claim 41 be reconsidered and withdrawn.

CONCLUSION

The undersigned believes that claims 33-49 are allowable over the cited prior art and respectfully requests a notice of allowance to this effect. Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

Date: June 27, 2006
By: */Dawn-Marie Bey - #44,442/*

Dawn-Marie Bey
Registration No. 44,442
KILPATRICK STOCKTON LLP
607 14th Street, N.W.
Suite 900
Washington, DC 20005-2018
(202) 508-5889
(202) 585-0041 fax